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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,318	02/21/2002	Hans Jaeger	770P0140685-US(PAR)	3830

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PERMAN & GREEN  
425 POST ROAD  
FAIRFIELD, CT 06824

EXAMINER

SCHLAK, DANIEL K

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 10/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/081,318

Applicant(s)

JAEGER ET AL.

Examiner

Daniel K Schlak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 8-12 and 14 is/are allowed.
- 6) ☒ Claim(s) 13 and 15 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

The Office records for the provisional applications from which the instant application claims priority show that provisional applications 60/270,796, 60/277,806, and 60/338,892 do not list the inventors of the instant application.

Applicant is required to remove the claim for priority to these applications or to provide some evidence to show that these applications can be properly established as priority documents for the claimed subject matter of the instant application.

Removal of the claim for priority should include the following steps:

- a) submission of a new declaration omitting the claim for priority; and
- b) amendment to the specification in the cross-reference-to-related-applications to remove these applications as being priority documents.

### ***Information Disclosure Statement***

The information disclosure statement filed 3/26/03 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it has not been submitted on form PTO 1449 and does not provide designated spaces for the Examiner's initials and signature. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for

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purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Further, the Examiner notes that the citations in the information disclosure statement are US patent applications and not published documents. However, the Examiner has cited in the "notice of references cited" the corresponding pre-grant publication documents for these applications, so that there should be no further action needed by Applicant or the Office in this matter.

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The disclosure is objected to because of the following informalities: on page 3, line 15, the word "fourth" has been misspelled "forth".

Appropriate correction is required.

### ***Claim Objections***

Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

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The claim merely describes the environment within which the feeder/separator is used, and does not provide any structural or functional recitations pertaining to the feeder/separator itself.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "the short letter control parameters" in lines 3-4.

There is insufficient antecedent basis for this limitation in the claim.

Further, claim 13 recites that the is adapted to "override the short letter control parameters.... that the different series.... are turned on for..."

To begin with, the recitation is vague for ending in a preposition. Secondly, a sensor cannot override anything. Sensors sense. Controllers override.

Further, what parameters were they "turned on for"? This has yet to be mentioned.

Claim 15 recites, in the last three lines, "and that nothing in said apparatus will stop said envelope past this sensor..." No sensor could ever determine this, and a claim for something that assures that "nothing" will stop said envelope is to say that it will keep moving for eternity. How can a sensor determine this?

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***Allowable Subject Matter***

Claims 1-6, 8-12, and 14 are allowed.

No art was retrieved which discloses the combination of six series of rollers, two series of belts, and the two brakes configured as described in the independent claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes the pre-grant publications that the Examiner has cited in response to the insufficient information disclosure statement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308 - 1113.

dks

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SUPERVISORY PATENT EXAMINER  
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